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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,955	01/04/2001	Kelly J. Reasoner	10004966-1	4771

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 06/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,955

Applicant(s)

REASONER ET AL.

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.3
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____

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1) The I.D.S filed 3/05/2001 and 9/09/2002 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

2) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested.

MEDIA STORAGE SYSTEM USING A TRANSPONDER FOR TRANSMITTING
DATA SIGNAL.

3) Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said control system" (claim 1, line 12) lacks clear antecedent basis. No "control system" has been previously recited in the claim and therefore the limitation cannot be understood.

Claim(s) 2-10 incorporate the indefiniteness of claim(s) 1 by virtue of their dependency thereon.

4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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5) (e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6) Claims 1,4-7,10-13,15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by BRADY et al (6,201,474).

BRADY et al discloses a media storage system having a plurality of data cartridge as claimed in claims 1,11,19 and 20, comprising:

A cartridge access device for retrieving and transporting the data cartridge (Fig.10, cartridge access device 322, data cartridge 100);

A transponder mounted on data cartridge for transmitting data signal related to data cartridge (Fig.1, data cartridge 100, transponder 120);

A reader mounted to cartridge access device for receiving signal from transponder (Fig.10, reader 320);

A controller for controlling the operation of media storage system (Fig.10, CPU 316).

As to claim 4, BRADY et al shows controller operates the reader to activate and query transponder when cartridge access

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device is positioned adjacent to data cartridge (Fig.10, data cartridge 100 is positioned adjacent to reader 320).

As to claims 5 and 6, BRADY et al shows transponder is passive transponder or active transponder in column 5, lines 41-49.

As to claim 7, BRADY et al shows transponder is RFID transponder (see the abstract).

As to claims 10,12,13 and 15, BRADY et al shows data related to the data cartridge includes at least cartridge information (see the abstract, the transponder will be activating during transmits signal and deactivation during interchange the data cartridges of at OFF state).

As to claim 16, BRADY et al shows forming an air interface between reader and transponder (Fig.10, air interface between reader 320 and transponder 120).

As to claims 17 and 18, BRADY et al shows the controller querying transponder to transmit data (Fig.10, CPU 316 querying transponder 120 transmits data to reader 320).

7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9) Claims 2,3,8,9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over BRADY et al (6,201,474).

BRADY et al discloses all the subject matter claimed as in claim 2 and 3, *except* to specifically show that the reader is mounted to cartridge access device. It would have been obvious matter of design choice to modify the BRADY et al's media storage device by mounting the reader to cartridge access device, since applicant has not disclosed that having the reader mounted at this specific location could solve any stated problem or is for any particular purpose and it appears that the media storage device would perform equally well with the reader mounted at any suitable locations.

Further, the modify the shapes and sizes of the cartridge

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access device as claimed in claim 3 has been recognized to be within the level of skill in the art.

As to claim 8, since BRADY et al discloses RFID transponder with memory which capable of storing data to any suitable capacity.

As to claims 9 and 14, it would have been obvious to someone within the level of skill in the art at the time of the invention was made to position the reader at 3 millimeters from the transponder in media storage device of BRADY et al. The rationale is as follows: since the reader of BRADY et al' media storage device is positioned at a short space from transponder for reading the data transmitted from the transponder (Fig.10, reader 320 is positioned close to transponder 120 of data cartridge 100), one of ordinary skill in the art at the time of the invention was made would have been motivated to position the transponder and reader at any suitable distances for reading and transmitting data.

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See form PTO-892 attached herein).

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

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11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

June 9, 2004